EXHIBIT 2

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USPTO PRESENTATION

John M. Whealan, USPTO's Deputy General Counsel for IP Law and Solicitor,
5th Annual Hot Topics In Intellectual Property Law Symposium,
Duke University School of Law, (Feb 17, 2006),

Contents:

1. CD-ROM containing the full video presentations of two sessions as downloaded from

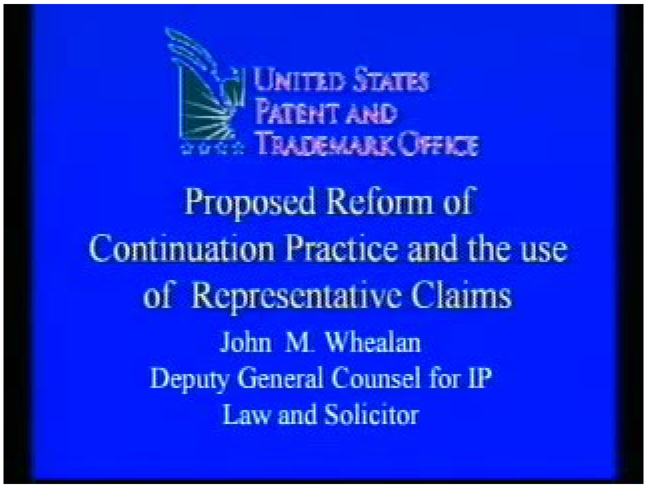
a) Presentations: http://realserver.law.duke.edu/ramgen/spring06/students/ 02172006a.rm, and

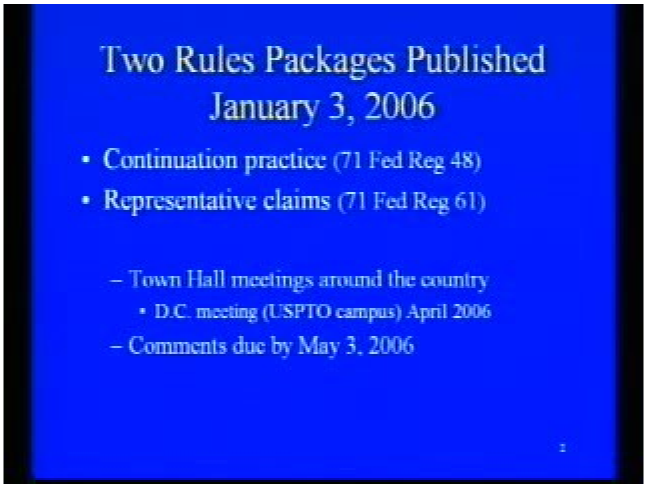
b) Q & A Session: http://realserver.law.duke.edu/ramgen/spring06/students/02172006b.rm .

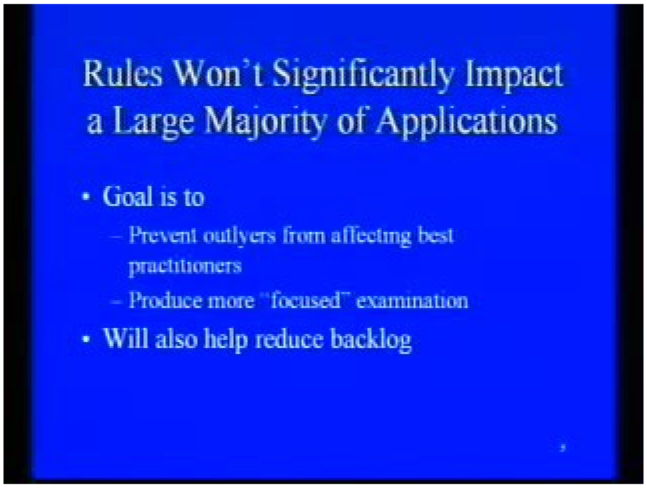
Thus, the entire contents of these video streams are incorporated herein by these references.

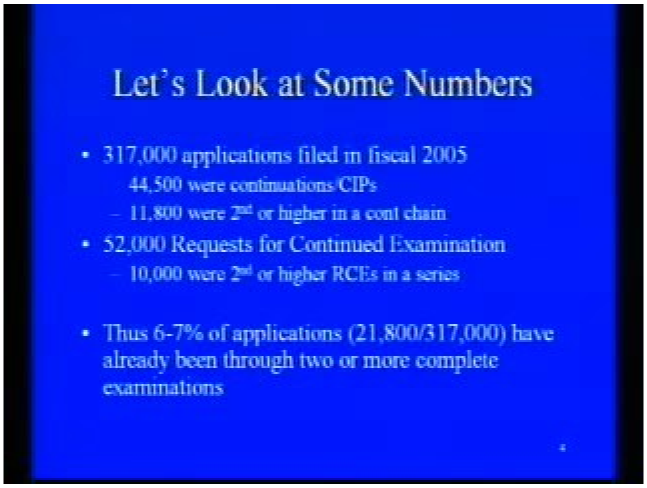
2. John M. Whealan's slide presentation as extracted from the presentations video.

CD-ROM


UNITED STATES
PATENT AND
TRADEMARK OFFICE
Proposed Reform of
Continuation Practice and the use
of Representative Claims
John M. Whealan
Deputy General Counsel for IP
Law and Solicitor

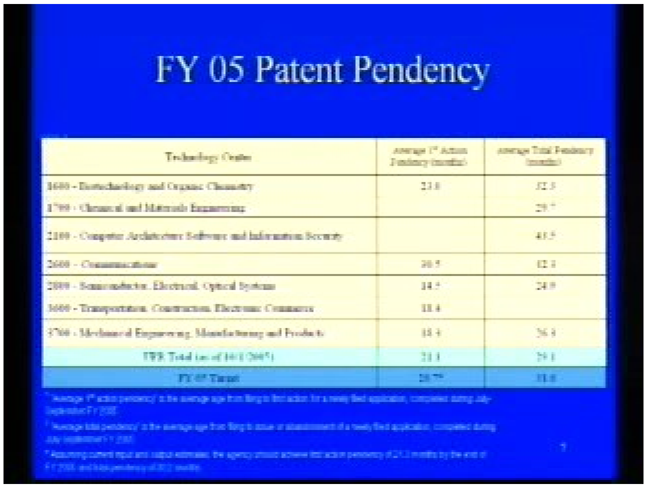

Two Rules Packages Published
January 3, 2006
• Continuation practice (71 Fed Reg 48)
• Representative claims (71 Fed Reg 61)
– Town Hall meetings around the country
• D.C. meeting (USPTO campus) April 2006
– Comments due by May 3, 2006


Rules Won't Significantly Impact a Large Majority of Applications
• Goal is to
– Prevent outlyers from affecting best practitioners
– Produce more "focused" examination
• Will also help reduce backlog


Let's Look at Some Numbers
• 317,000 applications filed in fiscal 2005
– 44,500 were continuations/CIPs
– 11,800 were 2nd or higher in a cont chain
• 52,000 Requests for Continued Examination
– 10,000 were 2nd or higher RCEs in a series
• Thus 6-7% of applications (21,800/317,000) have already been through two or more complete examinations

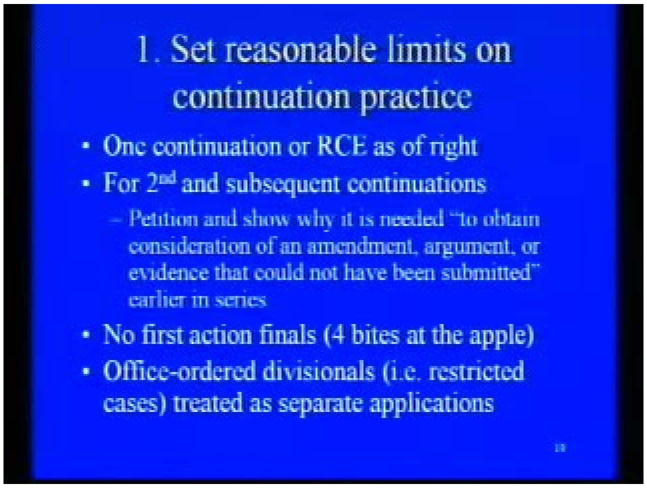
Continuation Filing Rates

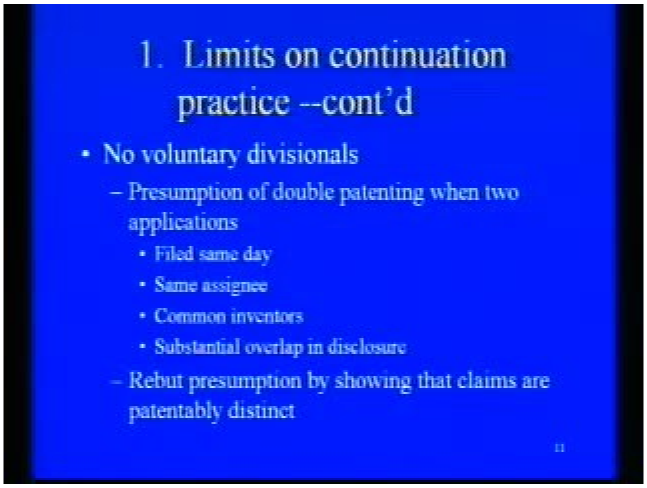
Continuation Filing Percentage

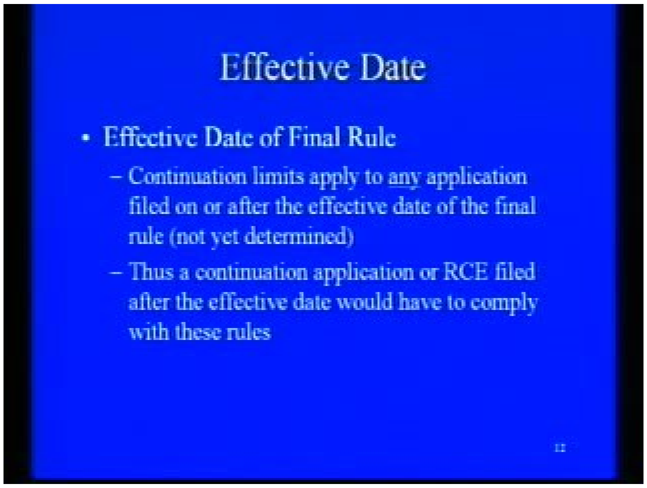

FY 05 Patent Pendency

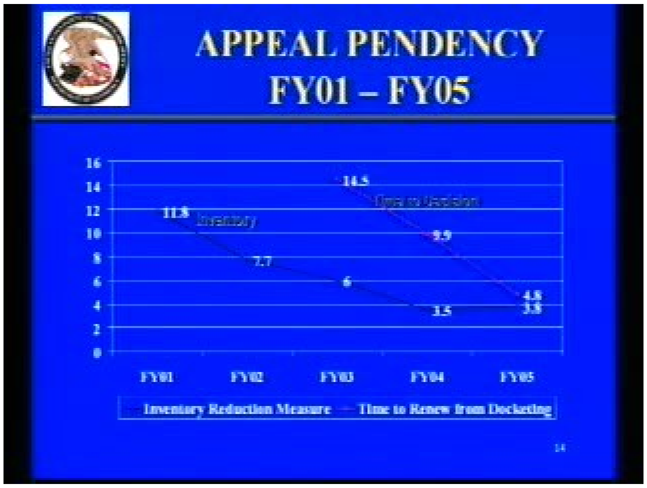
Technology Centers Rework* Statistics

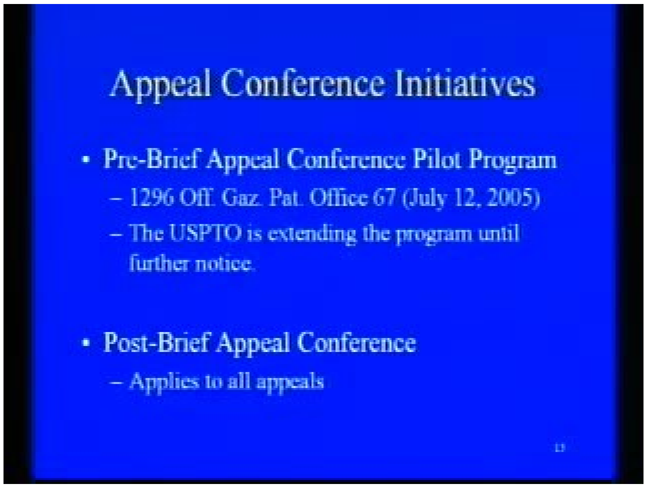
TC Summary	FY 2002 % FAOM Rework	FY 2003 % FAOM Rework	FY 2004 % FAOM Rework	FY 2005 % FAOM Rework
1600	36.4%	39.7%	40.3%	42.4%
1700	25.2%	26.9%	27.1%	28.0%
2100	23.9%	24.0%	24.6%	28.2%
2600	24.8%	24.1%	24.3%	25.4%
2800	19.1%	22.0%	24.9%	24.1%
3600	17.7%	21.2%	23.1%	28.5%
3700	22.2%	25.1%	24.0%	28.1%
UPR	**23.2%**	**25.3%**	**26.1%**	**28.3%**

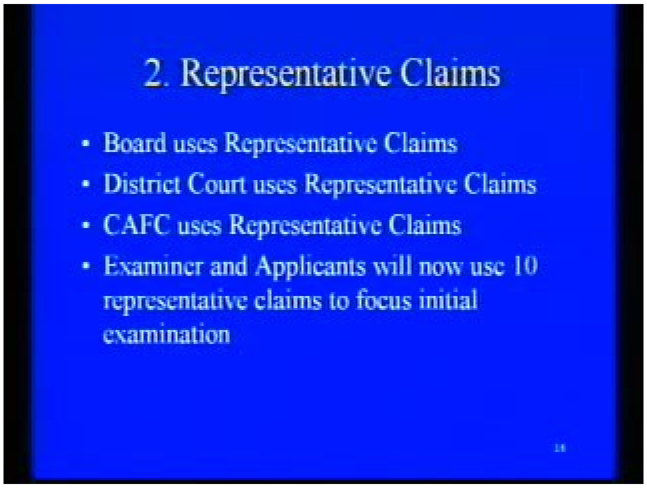

1. Set reasonable limits on continuation practice
• One continuation or RCE as of right
• For 2nd and subsequent continuations
– Petition and show why it is needed "to obtain consideration of an amendment, argument, or evidence that could not have been submitted" earlier in series
• No first action finals (4 bites at the apple)
• Office-ordered divisionals (i.e. restricted cases) treated as separate applications

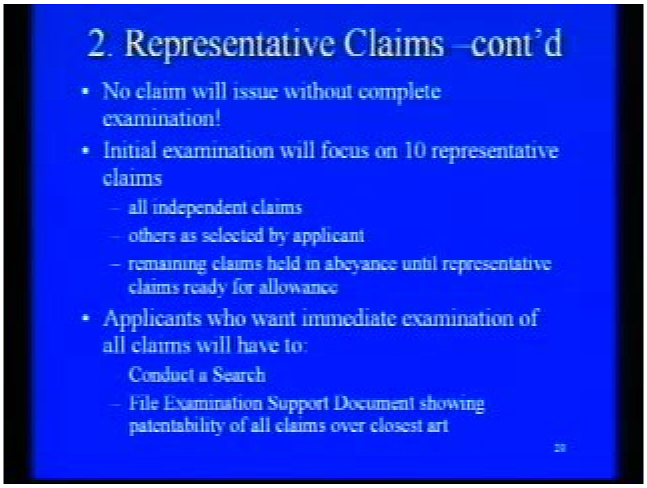

1. Limits on continuation practice --cont'd
• No voluntary divisionals
– Presumption of double patenting when two applications
• Filed same day
• Same assignee
• Common inventors
• Substantial overlap in disclosure
– Rebut presumption by showing that claims are patentably distinct
11

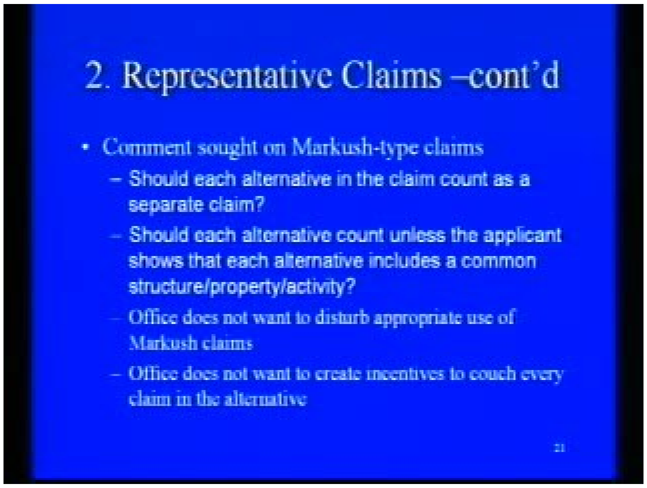

Effective Date
• Effective Date of Final Rule
– Continuation limits apply to any application filed on or after the effective date of the final rule (not yet determined)
– Thus a continuation application or RCE filed after the effective date would have to comply with these rules
12

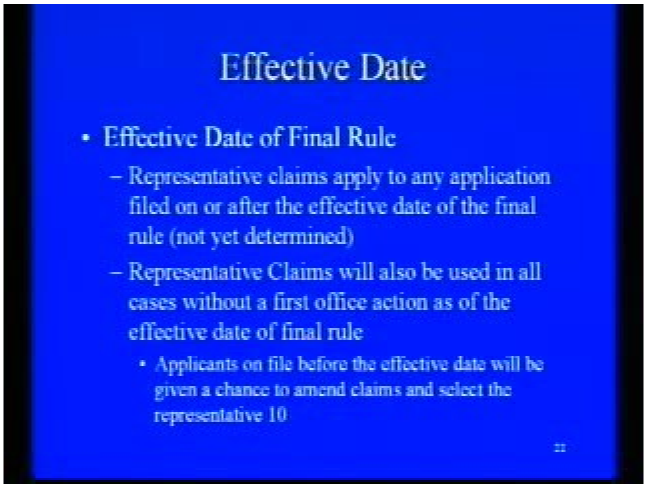

APPEAL PENDENCY
FY01 – FY05
16
14
12
10
8
6
4
2
0
11.8
Inventory
14.5
9.9
7.7
6
3.5
4.8
3.8
FY01
FY02
FY03
FY04
FY05
Inventory Reduction Measure
Time to Renew from Docketing

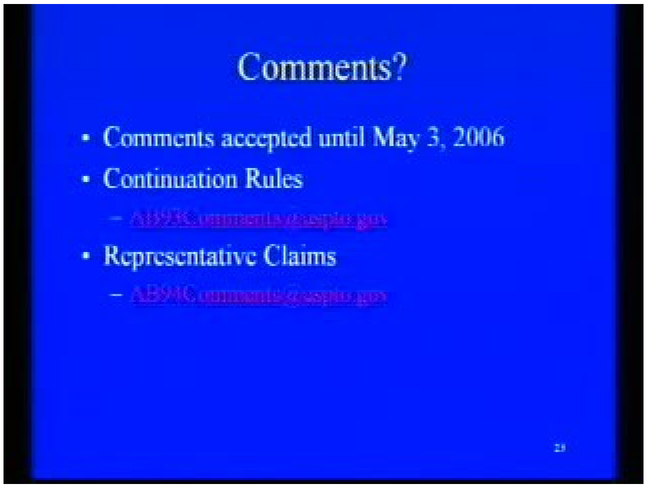

Appeal Conference Initiatives
• Pre-Brief Appeal Conference Pilot Program
– 1296 Off. Gaz. Pat. Office 67 (July 12, 2005)
– The USPTO is extending the program until further notice.
• Post-Brief Appeal Conference
– Applies to all appeals

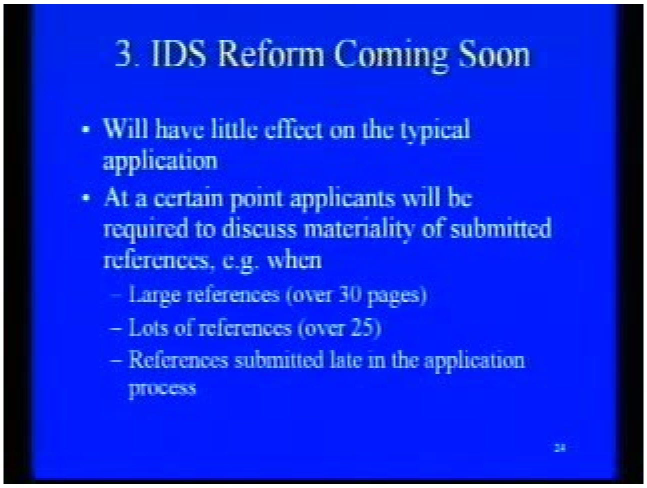

2. Representative Claims
• Board uses Representative Claims
• District Court uses Representative Claims
• CAFC uses Representative Claims
• Examiner and Applicants will now use 10 representative claims to focus initial examination

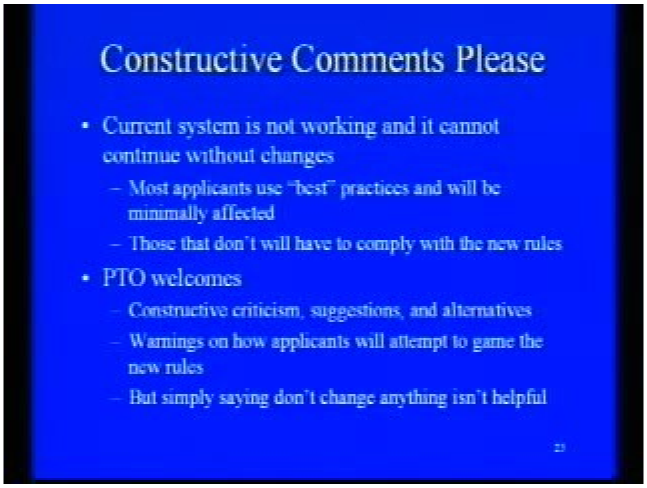

2. Representative Claims –cont'd
• No claim will issue without complete examination!
• Initial examination will focus on 10 representative claims
– all independent claims
– others as selected by applicant
– remaining claims held in abeyance until representative claims ready for allowance
• Applicants who want immediate examination of all claims will have to:
Conduct a Search
– File Examination Support Document showing patentability of all claims over closest art

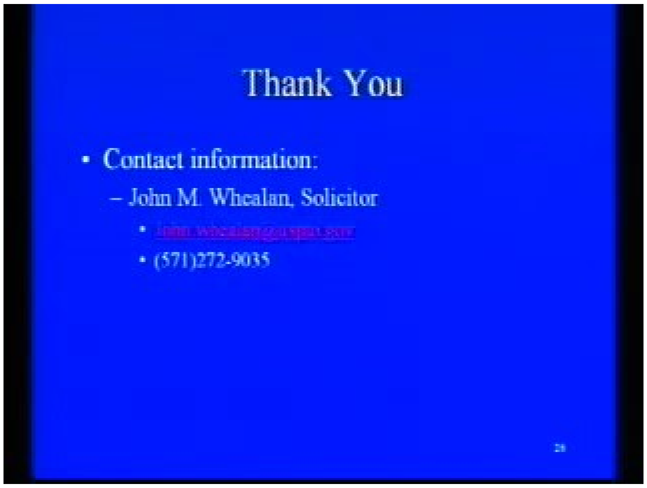

2. Representative Claims –cont'd
• Comment sought on Markush-type claims
– Should each alternative in the claim count as a separate claim?
– Should each alternative count unless the applicant shows that each alternative includes a common structure/property/activity?
– Office does not want to disturb appropriate use of Markush claims
– Office does not want to create incentives to couch every claim in the alternative
21


Effective Date
• Effective Date of Final Rule
– Representative claims apply to any application filed on or after the effective date of the final rule (not yet determined)
– Representative Claims will also be used in all cases without a first office action as of the effective date of final rule
• Applicants on file before the effective date will be given a chance to amend claims and select the representative 10


Comments?
• Comments accepted until May 3, 2006
• Continuation Rules
• Representative Claims


3. IDS Reform Coming Soon
• Will have little effect on the typical application
• At a certain point applicants will be required to discuss materiality of submitted references, e.g. when
– Large references (over 30 pages)
– Lots of references (over 25)
– References submitted late in the application process


Constructive Comments Please
• Current system is not working and it cannot continue without changes
– Most applicants use "best" practices and will be minimally affected
– Those that don't will have to comply with the new rules
• PTO welcomes
– Constructive criticism, suggestions, and alternatives
– Warnings on how applicants will attempt to game the new rules
– But simply saying don't change anything isn't helpful


Thank You
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